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EXAMINER	
RUHL, DENNIS WILLIAM	
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	09/876,408	BROWN, CHARLES P.	
	Examiner	Art Unit	
	Dennis Ruhl	3689	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *23 August 2010*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-9,11-13,19,21-24 and 34* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-9,11-13,19,21-24 and 34* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 8/23/10 has been entered.

The instant examiner has reviewed the prosecution history to date and has reviewed the presently pending claims in view of the originally filed disclosure. The instant examiner also conducted an updated search of US patent documents and of NPL prior art on the Internet in order to more fully examine the state of the prior art as of the filing date of the instant application. During review of the instant application and currently pending claims numerous issues were identified that need to be addressed in the record. Additionally new prior art has been discovered that is deemed by the examiner to be highly relevant to the claimed invention.

2. Claim 2 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form.

For claim 2, the claim is an improper dependent claim. Applicant cannot recite a computer readable medium claim as depending from a method claim, this is not proper. This type of claim will not pass the "infringement test" for determining if a claim is a

proper dependent claim. In this case, one could infringe claim 1 without infringing claim 2, and vice versa. Claim 2 cannot contain all elements from the claim it depends from, because it is not a method claim where steps are occurring. Claim 2 covers only the CRM that has the instructions, not the actual steps themselves, whereas claim 1 covers the execution of the positively recited method steps.

3. 35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. Claim 2 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Applicant should take notice that claim 2 is directed to a computer readable medium that contains instructions to execute the method of claim 1, so this claim is not treated as if it were a method claim. While this is not a proper dependent claim (see below 112 rejection), this claim has been treated as an independent claim for examination purposes. This is to expedite the issues involved with computer readable mediums type claims. The term "computer readable medium" is known in the art to include things such as signals. Based on the broadest reasonable interpretation that this term is to be accorded, it includes signals and is not considered to be statutory. If applicant were to amend this claim to be a proper independent claim, language such as "A computer readable storage medium" and/or a "A non-transitory computer readable medium" both appear to be acceptable language in the opinion of the examiner. As it

stands now, assuming applicant is claiming a computer readable medium that stores instructions to execute the method of claim 1, this is not statutory for the above reasons.

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. Claims 1-9,11-13,19,21-24,34, are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

For claims 1-9,11-13,19,21-24,34, applicant has amended the claim to contain new matter that is not supported by the specification, claims, and figures as originally filed. The instant examiner has reviewed the originally filed specification numerous times. In the opinion of the examiner there are some things in the claim that did not appear in the originally filed specification. The examiner could not find where the original specification disclosed that the client network device was comprised of more than one processor, which is in the claimed scope. This appears to be new matter. The registration system server was disclosed as being able to be more than one server/processor, but the examiner could not find any disclosure to the client device having *more than one* processor. The limitation of “sending a response” from the domain name server to the client device to request a one-time permanent registration is

not disclosed in the originally filed specification. It was disclosed that a fee was received, and that the fee was a one time fee used to provide for permanent domain name registration, but it was not disclosed that a request is received from a client device for a permanent renewal, and that *"a response is sent from the domain name server to the client device"*. Part (b) of the amended claim is not support by the specification as originally filed. With respect to section (d) of the claim, it contains new matter in the opinion of the examiner. It is claimed that the creating of an electronic record (the permanent registration) "automatically triggers" *the domain name server* to determine and verify all current renewal fees, "automatically triggers" the use of a first portion of the fee payment to automatically pay all current renewal fees, and "automatically triggers" *the domain name server* to automatically determine and verify all future renewal fees, and "automatically triggering" the use of a second portion of the payment fee to pay for all future renewals. This is simply not supported by the specification after a fair and reasonable reading of the specification as originally filed. It was never stated that any automatic triggering of anything was happening, and there is definitely no disclosure to the server being automatically triggered into doing what is claimed as a result of the creation of the electronic record. There is no automatic triggering of any kind disclosed in the specification as originally filed. The server is not claimed as doing the claimed acts in response to the electronic record being created. Also, the server is not necessarily even disclosed as doing all that is claimed. The specification is full of result oriented language that is explaining what is happening or occurring, but is silent as to whether that step is performed by the domain name server or a person. The

examiner cannot find any disclosure to the domain name server doing what is claimed automatically and in response to the creation of the electronic record. For example, with respect to the use of the first and second portion of the fee payment, it was never disclosed that the domain name server even had anything to do with the determination of the first portion. The specification appears to be silent as to what entity or device is performing that step. Claim 1 contains new matter that is not supported by the specification as originally filed. For claim 34, in a similar analysis to that of claim 1, claim 34 contains the same new matter issues and problems. The only difference is that claim 34 is attempting to use means plus function language under 35 USC 112,6th paragraph. Claim 34 is rejected for the same reasons as claim 1 with respect to new matter.

7. The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

8. Claims 1-9,11-13,19,21-24,34, are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

For claims 1-9,11-13,19,21-24,34, the examiner is having trouble understanding how the scope of the claims could possibly be enabled. Applicant is claiming that

payments are made so that the domain name registration can be ***permanent***. The independent claims contain language referring to “all future” payments and a permanent registration of the domain name. As far as the concept of being able to do something like making all future payments and being able to ensure and predict how to keep the domain name registration "*permanent*", this is not enabled to one of skill in the art in the opinion of the examiner. The examiner takes the position that the applicant cannot predict for and account for all that may happen in the future that would affect the payments necessary to maintain a domain name registration for all of eternity (perpetually, permanent, forever). Applicant has not taught to one of skill in the art how to go about and predict what the future will bring and how one can go about and make all future payments as claimed. What if the price to have a website goes from being affordable to being one million dollars a year? How would one of skill in the art go about and account for the fact that Internet domain name registrations might cost one million dollars a year in another 150 years? What kind of investment is taught that could ensure that enough money is on hand to afford one million dollars for each website? Applicant did not invent a system that can operate perpetually, that is impossible. The examiner sees this as being very close to claiming a perpetual motion machine, at least as far as being able to do something perpetually into the future to claim that something is permanent. The issue of how long a website can stay on the Internet, or how long a domain name may be registered is affected by many things, such as possible nuclear war, rising costs for Internet usage, or possibly the outright death of the Internet in favor of yet to be invented new kind of communication network. How can applicant ensure

that any given domain name registration would be kept current in 50,000 years if the world we live in and/or the Internet are not around anymore? One of skill in the art would not be able to design and implement a system as claimed that can perpetually ensure that all future payments are made so that the domain name registration (or website if there is one) can be *permanent* as this would necessarily involve undue experimentation and involves so many different variables that there is no predictability at all, especially when one takes into account that we are dealing with a permanent thing. That means that the claim is attempting to cover acts that might occur an "infinite" number of years for now, such as 999,999,999 years from now. The examiner would like to know how applicant can perpetually make all future payments to make the domain name registration permanent (even if there is no electricity to operate a network of computers, such as after a natural disaster or world wide nuclear war). Nothing is permanent, not even the Internet or domain name registrations. Also, the originally filed specification even disclosed that insurance can be offered to the customer, so that in the event that the domain name registration or website is not renewed in time, the customer is covered to some extent. The specification itself seems to recognize that the guaranteed payment and guaranteed existence of any given internet website cannot be ensured. That is why applicant is offering insurance, just in case the payment for the domain name registration or website is missed and is not paid. Applicant clearly cannot control and predict the future and the specification seems to recognize this fact, by offering insurance for not renewing a domain name registration renewal. The examiner concludes that one of skill in the art would have to undergo undue experimentation to

arrive at a system that can make payments all future payments that result in a "permanent" domain name registration.

For part d) of claim 1, one of skill in the art could not make the claimed invention without undue experimentation so that upon creating of an electronic record as claimed, the server would be able to "determine and verify all future renewal fees" as well as using a second portion of the fee payment to pay for all future fee payments for the existing domain name registration. Not disclosed is how one can go about determine all future renewal fees as claimed. Again, the future cannot be predicted and the examiner does not feel that anyone can make anything that is permanent. How can the server go about the determine all future renewal fees? At best the only fees that could be determined are the ones that are due currently, or that are due in the very near term. How can the server figure out and predict what the fees are going to be in another 200 years? Nothing is taught about how this is done. The fees and regulations governing domain name registration may change in 100 years to be something other than anything we can contemplate now in the year 2011. Nobody, not even one of extra high skill in the art can predict the future and take into account all possible facts that would come into play and determine the domain name registration fees for the future. How would one of skill in the art go about and use the second portion of the fee to pay for all future fee payments? What kind of investment strategy or procedure has applicant used to ensure that any possible fees in the future can be paid, even if they are one million dollars a year for each domain name registered? There is no way applicant can guarantee or even predict with any reasonable expectation of success as to how much

a domain name registration will cost in 100 years, and there is no way that applicant can use a portion of the fee to account for fees in the future, when nobody knows what the future will bring. There mere fact that if the second portion were invested smartly and did increase in value, and if domain name registrations remain at the same relative cost level into the future forever (permanent), one could possibly pay for future fees, this would be nothing more than mere coincidence or just being lucky. The fact that what is claimed could happen in not satisfying the enablement that explains to one of skill in the art how to go about and do what is claimed without undue experimentation. It might be true that if you had enough money, you could maintain a domain name for a long time into the future, but investing and determining how much it will cost to register a domain name hundreds of years from now it simply not a guaranteed thing and is not predictable in the least. Applicant has not disclosed anything that would enable one of skill in the art to make the invention, specifically to make a server that can account for all possible and necessary domain name registration fees that could ever possibly be required in the future, along with using a portion of the fee payment to pay for all future fees. Too many factors come into play that the predictability is so low that nobody can predict what might happen 50 years from now, let alone hundreds of years from now.

For claim 19, the same is true for the web hosting limitation and paying all future web site hosting fees with a portion of the fee payment. *For the same reasons* as addressed immediately above with respect to the future payments for the domain name registration, the same is applicable to the future fees for the web site hosting service which is not considered to be enabled to one of skill in the art.

9. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

10. Claims 2,9,13,34, are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

For claim 2, the claim is an improper dependent claim. It is not clear if performing the method would be infringing the claim, or if merely possessing a computer readable medium that was storing instructions that could cause the method to occur would be infringing the claim. Applicant cannot recite a computer readable medium claim as depending from a method claim, this is not proper. This type of claim will not pass the "infringement test" for determining if a claim is a proper dependent claim. In this case, one could infringe claim 1 without infringing claim 2, and vice versa. Claim 2 cannot contain all elements from the claim it depends from, because it is not a method claim where steps are occurring. Claim 2 covers only the CRM that has the instructions, not the actual steps themselves, whereas claim 1 covers the execution of the positively recited method steps. This is why claim 2 is an improper dependent claim that is considered to be indefinite because it is not clear under what conditions infringement would occur.

For claim 9, it is not clear as to what format is being claimed. By reciting a format “other than" that of the electronic registration certificate, what does that mean? Applicant is claiming what the format is not, and is not reciting what the format is in a

positive sense. In this case, the use of a negative limitation is considered to render the claim indefinite.

For claim 13, similar to that of claim 9, applicant has claimed how the fee is not received, not how it is being received in a positive sense. This is not clear. What manner of receipt is defined here? In this case, the use of a negative limitation is considered to render the claim indefinite.

For claim 34, applicant's usage of means plus function language is considered to render the claim indefinite. Applicant is claiming numerous means plus function limitations. Applicant has claimed a means for receiving a request for renewal of a registration. What structure does this cover from the specification? The specification may disclose that a request is received, but that is not sufficient to convey what the covered structure is. The same is found for the means for sending a response, except that this limitation appears to be new matter so the issue of it not being clear what is covered from the specification is relevant because it does not appear to even be part of the originally filed specification. If the specification never disclosed this feature, it clearly did not convey the covered structure of this feature. Applicant claims a second means for receiving. What is that specifically and how does it differ from the first recited means for receiving a request? It is not clear what *structure* covers the means for receiving a request, and what different structure covers the means to receive the fee payment. How do they differ? This is not clear. It might be that the means for receiving are actually the same thing as they both receive data. At any rate, it is not clear what is covered by this language after consulting the specification. With respect to the means

for creating an electronic record, the specification does not disclose what the covered structure is. The specification may disclose that an electronic record is created, but that is not enough to satisfy the requirement to disclose what the covered structure of the means plus function language is. For the means for creating limitation, it is not clear what structure covers this language. Where did the specification disclose the structure that is used to accomplish the act of creating an electronic record as claimed? It was disclosed that an electronic record was created, but the structure by which it is created is not disclosed and is not at all clear. The means for adding language has the same problem. What structure to the system is disclosed as accomplishing the act of adding a second portion of the fee to an investment instrument that can pay for all future fees? What structure does this? From the specification, as best the examiner can tell, the means to add the portion of the fee to an investment is a person and has nothing to do with the machine. The same is found for the limitations of the means for issuing and means for providing access. It is not clear what the associated structure is from the speciation that this 112,6th language covers.

Also, the specification states that various elements of the invention have been described as being software, but in other embodiments it may include hardware, See page 41 of the originally filed specification. What embodiment is being claimed here? The purely software embodiment or the embodiment that includes hardware? The examiner is very concerned that the current claim 34 reads on nothing more than software, even though the steps that the software might execute to accomplish the recited functions is not clear. In the event that applicant argues to the instant examiner

that the structure of a computer (processor, memory, etc.) is what the covered structure is, the examiner would additionally question where the specific algorithms have been disclosed for the claimed means plus function language. Using means plus function language does not relieve applicant from the duty to provide the actual algorithm as far as the specific steps that the computer would perform to accomplish the recited function. The mere disclosure to a generic computer is not sufficient to satisfy the burden to disclose the covered structure when using a 112,6th limitation. What algorithm (what actual steps) are performed by a computer to allow the receipt of a request to occur? What algorithm (what actual steps) are performed by a computer to allow the sending of a response to occur? What algorithm (what actual steps) are performed by a computer to allow the creation of an electronic record to occur? What algorithm (what actual steps) are performed by a computer to allow the portion of the fee to be added to a financial instrument? The same is applicable for the remaining limitations to claim 34. This is not clear from reviewing the originally filed specification and renders the claim indefinite. Prior art has been applied to claim 34 as the claim is best understood by the examiner.

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

12. Claims 1-9,11-13,34, are rejected under 35 U.S.C. 103(a) as being unpatentable over Fellman (20020065903) in view of the Tonic 100 year domain name registration service "Register your domain name for 100 years; www.tonic.to becomes the first domain registry to offer multi year registrations" (9/23/1999), hereafter referred to as "Tonic", and "Tonga to offer 100 year domain name registrations, 9/22/1999, hereafter referred to as Tonga".

Applicant should take notice that the examiner is considering the Tonic and Tonga reference to be one prior art reference. This is because both articles are discussing the 100 year domain name registration service that Tonga offered in 1999. Both references are discussing the same thing, both references are quoting CEO Eric Lyons. The Tonga reference can be considered as a teaching of inherent properties that the Tonic reference contains as far as the use of a multiple reference 102 is concerned (multiple references used effectively as one prior art reference).

For claims 1,2,3,11,12,34, Fellman teaches a domain name registration system that can be used for the registration of a domain name. In paragraph 007, Fellman discusses what a "registrar" is and discusses the fact that the registrar can interact with the authoritative database (ICANN) for purposes of checking and registering domain names. In paragraph 32 it is disclosed that a user computer (*client device*) is used to

send a *request for a domain name registration* to a *web server 110* via the *Internet*. Fellman is basically directed to a registrar system that provides the service to customers of registering domain names on their behalf with the governmental/authoritative database for domain name registrations. Fellman teaches that it was well known in the art to use the Internet to communicate with a domain name server (110) for the purpose of registering a domain name. Fellman teaches the overall idea of accepting and processing a domain name registration via the Internet. Fellman discloses the *sending of a response to the client device to request payment of a registration fee*. Figure 3 is an example where it can be seen that the user is given a message in the form of a textual display that informs them of how much it costs to register a domain name. A "Begin Registration" button can also be seen in figure 3. Figure 3 also shows a pricing and services link on the left side. Also disclosed by Fellman is the *creation* and *issuing* of a *registration electronic record and/or a registration "certificate"* for the existing domain name. Figure 10 is representative of an electronic record that has been displayed to the customer in the form of a registration certificate (*access has been provided to the customer* as claimed). Upon successful registration a user is presented with a display that is considered to satisfy the claimed *electronic registration certificate*. The user is presented with information regarding the successful registration of the domain name, the expiration date, and information on how much money has been charged to a credit card in the form of a payment fee for the domain name registration. All of this is stored in a database and satisfies the claimed electronic record and the electronic record in the form of a registration certificate. Fellman inherently has

accepted a fee payment electronically as is evidenced by figure 10 , "*Your credit card has been charged $275.00*". Fellman receives a fee from the client device to the domain name server as claimed.

Not disclosed by Fellman is that the domain name registration is for a domain name registration *renewal*, and that the renewal registration is permanent in the sense that the registration will go on forever.

Also not disclosed in Fellman is that once the payment has been made for a permanent registration renewal, the domain name server automatically determines and verifies all current fees due for the registration renewal, along with the determining and paying of all future fees as has been claimed. Not disclosed is the recited first portion of the payment fee being used to pay current fees, and a second portion of the payment fee being used to pay future renewal fees.

Not disclosed is the use of a financial instrument as claimed that allows for profits to be made on a portion of the fee payment, so that future payments for domain name registration renewals can be made.

With respect to the limitation that the request for the domain name registration renewal is a permanent registration request, Tonic discloses the fact that Tonic Domains Corporation announced their new "multi year registration plan" for Internet domain names. Specifically disclosed is that customers now have the option of an initial or *renewal* registration for one, two, three, five, ten, 25, or 100 years. Only one payment is required for the entire term of the registration. It is also disclosed that customers previously were limited to a maximum two year registration period. As stated

in the Tonga article, "*With competition heating up in the Net game registration market, the kingdom of Tonga is pushing a new gimmick to popularize its ".to" domain-lifetime leases*", see page 1 of Tonga article. President and CEO Eric Lyons is quoted as saying "*We want to make it easy for people to keep their good domain names*" and "*Once you choose a domain name for your web site, you want to make sure that its always going to be there.*", see Tonic. Also stated in Tonic by CEO Lyons was that "*You shouldn't have to worry about renewing your domain name every year.*" CEO Lyons also stated that the short term domain name registration systems were a legacy of the first system put in place, and in 1994, it was decided that registrations would be limited to just two years. That is a teaching that the time period for domain name registration was taken into account and was decided upon as being limited in term. CEO Lyons stated that they wanted to make sure that nobody forgets to re-register their domain name. Specifically stated was "*We want to make sure that never happens again. At least for the next 100 years.*" Tonic discloses that a request for a domain name *renewal registration* can be used to secure a domain name registration for up to 100 years, which is effectively a permanent registration to a human being. Also known in the art as being part of the Tonic domain name registration system is that the 100 year registration costs $2500. In the Tonga article, CEO Eric Lyons was quoted as saying "*If you want, you'll never have to register this name again, or get billed again.*" when referring to the 100 year domain name registration. Also known is that Tonic offered other value added services to garner and keep customers, such as a one stop shop for email and web page forwarding.

With respect to the issue of having a *permanent renewal registration*, in view of Tonic and the fact that they are providing for a 100 year domain *name renewal registration*, one of ordinary skill in the art at the time the invention was made would have found it obvious to provide Fellman with an advertised registration period beyond the 100 years advertised by Tonic by advertising the registration as a permanent registration that never expires. The prior art of domain name registrations initially limited the registration to one or two years. Tonic/Tonga teaches that it was known as of 1999 to provide for a longer term of registration and the article even refers to Tonic as being *the first* domain name registration service to offer multi year registrations. Tonic refers to the 100 year registration as allowing one to ensure that your website will "*always*" be there. One of ordinary skill in the art would readily and easily recognize that one could also provide a 200 year registration, a 500 year registration, 1000 year registration, etc., or even a permanent registration that would go on forever. This is just one of ordinary skill in the art taking it to the next level and offering a longer term than the 100 years that Tonic was known to have offered in 1999. One could say that would be “upping the ante” by offering a longer term than Tonic is offering. In an effort to stay competitive in the market and compete with the 100 year registration service, one of ordinary skill in the art would be motivated and find good reason to also offer longer extended periods for the registration term. This involves nothing more than ordinary skill in the art and is simply deciding to have a very long registration term because it is permanent. Going from a prior art 100 year registration period to longer periods such as 500, 100, 10000, or even permanent is well within the understanding and knowledge

that one of ordinary skill in the art would possess. Also, because of the fact that registrations were initially limited to one or two years, this is in essence a teaching that somebody decided that longer registration periods were not desirable. This teaches to one of ordinary skill in the art that the alternative is also possible, namely having no time limit on the period for the domain name registration. This is in essence what Tonic has done by being the first to go beyond short term domain name registrations and providing what are effectively lifetime 100 year registrations as far as any individual is concerned. One of ordinary skill in the art who wanted to go further than Tonic had gone, in an effort to remain competitive in the market of domain name registrations, would have found it obvious to offer and advertise a longer domain name registration period that went beyond 100 years by being a permanent domain name registration As stated in the Tonga article, "With competition heating up in the Net game registration market, the kingdom of Tonga is pushing a new gimmick to popularize its ".to" domain-lifetime leases, page 1 of Tonga article. Providing a permanent registration is akin to another marketing gimmick, just involving a longer registration period than Tonic provided. Knowing that registrations started with one or two years, then progressed to allowing for 5, 10, 25, or even 100 years as disclosed by Tonic, the next logical step for one of ordinary skill in the art is to keep increasing the registration period and make it longer than 100 years. One of ordinary skill in the art would have found it obvious to extend the offered registration term so that it was a permanent registration as claimed for the above reasons.

With respect to the domain name server automatically determining and paying all currently due renewal fees, this would have been obvious in view of the prior art rejection of record and is something that naturally flows from the rejection of record. When one of ordinary skill in the art is requesting and receiving a permanent domain name registration renewal, Fellman would have to pay the authoritative database (such as ICANN) to actually register or renew the domain name, as is well known in the art to one of ordinary skill. Fellman is acting as a registrar, and when they receive money from a customer to renew their domain name registration, and when a data file/data records regarding the registration request is created for the current transaction, part of the received renewal fee must be paid to the authoritative entity that controls the domain name registry to pay for currently due renewal fees. This flows from the reason that the customer is paying Fellman in the first place, which is to renew a domain name registration on behalf of a customer. Obviously part of the payment for the permanent registration would have to be used to automatically pay any currently due fees. The server of Fellman already is taught as communicating and accessing the main registry maintained by the entity that is in charge of domain name registrations (such as ICANN) to obtain domain name registration information related to a domain name registration. To further provide for the ability to automatically determine and pay any currently due fees would have been obvious to one of ordinary skill in the art. You have to pay the fees that are due to renew a registration and to do that, you must determine what fees are due. This flows from the rejection of record when using servers to affect a domain name registration and would have been obvious to one of ordinary skill in the art.

As stated previously, the claimed language regarding the use of a second portion of the payment fee to pay for all future renewal fees, and the use of the second portion of the fee in a financial instrument so that interest can be earned is not disclosed in the prior art. In the rejection of record a customer is paying for a permanent registration. When this happens there is going to be left over money after paying any currently due renewal fees to the authoritative entity. When a customer requests a permanent registration renewal and pays a fee (that could be in the thousands of dollars or even the tens of thousands of dollars), not all of the money is needed to renew the registration at this time. This would be because the authoritative entity does not provide for permanent registrations. The registrar is taking over the responsibility of paying for the domain name renewal in future years. A person of ordinary skill in the art would easily recognize that if you received a permanent renewal fee on the order of $10,000, and you only needed maybe $50-$75 to register the domain name for another registration time period, you would have a lot of left over money. One of ordinary skill in the art would clearly be motivated to use the extra money and put it to work in the form of some kind of investment. This could be something as simple as an interest earning savings or checking account or an interest earning certificate of deposit. Financial instruments in the form of interest earning savings and checking accounts, as well as certificate of deposit accounts are very well known in the art and the examiner takes official notice of this fact. There is no dispute that one of ordinary skill in the art is aware of interest earning accounts such as a savings account or checking account, or even a CD that earns interest. One of ordinary skill in the art who is receiving a lump sum

payment in the form of a permanent registration payment fee that is supposed be used to pay for future renewals of a domain name registration would need to put that money aside to ensure that it is there to pay the future renewals, that you have already agreed to pay for by accepting the permanent registration fee from the customer. One of ordinary skill in the art at the time the invention was made would have found it obvious to use a second portion of the payment fee that is not needed to pay any currently due registration fees and put it into a financial instrument, such as an interest earning savings account or checking account so that interest can be earned on the second portion of the payment fee and so that there is money put aside to pay any and all future registration renewal fees. This is something so basic to business in general and investing in general that it is hard to see how the use of a financial instrument such as an interest earning checking account by a business owner such as Fellman involves anything more than ordinary skill in the art.

With respect to claim 34 and the recited means plus function language the prior art rejection of record satisfies what is claimed. The examiner has addressed every function or step that is recited in conjunction with the term "means" in the prior art so the examiner has the claimed structure of clam 34. This is all in view of the indefiniteness of the claim and as it is best understood by the examiner.

For claims 4,5, not disclosed is that an “insurance policy” or a “title” is issued with the permanent registration certificate, where the insurance policy or title covers losses associated with not properly renewing a domain name registration (even though applicant has already claimed that all future payments are being made in claim 1).

Insurance (applicant calls it a title in claim 5) is well known in the art as being used to protect and cover an individual against some kind of loss. Insurance is used with things such as cars (liability and comprehensive coverage), houses (homeowners insurance), medical malpractice insurance for a practicing physician, and even insurance on a loan such as mortgage insurance. An insurance policy can be taken out for just about any situation one can think of. One of ordinary skill in the art would recognize and understand that one can insure anything against any kind of loss. It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide insurance to the customer that protects them against possible failure to renew their domain name registration. A registrar such as Fellman taking on the responsibility and liability for making all future renewal payments to the authoritative entity (such as ICANN) would surely want to protect themselves against a lawsuit in the event that they do not make a required payment in the future to renew a domain name registration. To use insurance as a way to cover Fellman and the customer from losses resulting from not renewing a domain name registration is something that would have been obvious to one of ordinary skill in the art. This claim is just reciting the use of insurance for what it is designed for in the first place, namely to protect against losses associated with a particular event. The kind of event that the insurance is associated with is not something that involves more than ordinary skill in the art.

For claims 6,8, not disclose is the issuing of shares (ownership certificates) as claimed, where the shares allow ownership interest to be sold. The examiner notes that nothing is actually being sold or distributed to more than one owner so the idea of

ownership shares in a general sense is all that is claimed. Similar to claims 4 and 5, applicant did not invent the idea of ownership shares in general for something of value such as a domain name. It is well known that domain names are items of great value. One of ordinary skill would be very much aware of this fact. Applicant is using the idea of ownership shares with a domain name for the same reasons that people use ownership shares in the first place, which is to allow multiple owners to have a share in something of value. It would have been obvious to one of ordinary skill in the art at the time the invention was made to allow for shares to be sold and associated with a domain name registration as claimed. This is just taking the general idea of ownership shares, such as are used in vacation timeshares, stocks, and really anything of value and applying it to domain names. Many married persons are co-owners in their home. That is a very common and basic form of ownership shares. Providing for the mere ability to sell ownership shares for the domain names is something that would have been obvious to one of ordinary skill in the art.

For claim 7, not disclosed is the issuing of a lease or a sublease. Both leases and sublease are very well known in the art. The examiner notes that no leasing or subleasing is actually occurring so the general idea of a lease or sublease is addressed. One of ordinary skill in the art is very aware of the fact that things of value such as domain names can be leased. Anything can be leased. Items known as being leased include raw materials used in a production process (Lend Lease Act of World War I), cars, gold mines, property, computers, data storage, and just about anything that one can think of. It would have been obvious to one of ordinary skill in the art at the time the

invention was made to allow for leasing or subleasing to occur with domain names, so that an owner of a valuable domain name can use the domain name to generate income in the form of lease payments. This is something obvious to one of ordinary skill in the art. Applicant is just claiming the use of a lease or subleasing for what they are designed for, to allow one entity to use an asset while the original owner retains actual ownership of that asset. Applicant is claiming the use of a lease for what leases provide for in the first place. This involves nothing more than ordinary skill in the art.

For claim 9, not disclosed is that the registration certificate is in a format other than electronic. The examiner views this as going backwards in the art and providing a paper registration certificate to the customer. Because the use of paper certificates are so well known, such as paper titles for a car owner, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide a paper hard copy of the registration certificate so that the customer had an actual real copy of the registration certificate for their record. Current technology has gone from paper to electronic format and claim 9 is claiming the old way of doing things, such as by providing paper registration certificates as opposed to electronic copies. This is well within the knowledge of one of ordinary skill in the art.

For claim 13, not disclosed is that the payment is made by other than the Internet. This is just claiming that the payment could be made by phone or by mail, both of which are old and well known in the art. It would have been obvious to one of ordinary skill in the art to allow for payments to be made by phone or by mail, so that customers who maybe cannot pay via a credit card via the Internet can still request and

render payment for domain name renewal registrations. This would allow a customer to send in a money order to pay for a registration renewal, or even use the phone to talk to an employee of Fellman and to give them a credit card number over the phone to pay for their registration services.

13. Claims 19,21-24, are rejected under 35 U.S.C. 103(a) as being unpatentable over Fellman (20020065903) in view of the Tonic 100 year domain name registration service "Register your domain name for 100 years; www.tonic.to becomes the first domain registry to offer multi year registrations" (9/23/1999), hereafter referred to as "Tonic", and "Tonga to offer 100 year domain name registrations, 9/22/1999, hereafter referred to as Tonga" and further in view of "Lasting respects Internet sites, memorialize the departed" (10/16/1999).

For claim 19, the limitation of accepting the domain name for which the renewal registration is requested is part of the act of renewing a domain name. The customer must inform the registrar (Fellman) of the domain name that they wish to have renewed; otherwise, they cannot renew the registration on behalf of the customer. This is necessarily required to be able to renew the domain name for the customer. This is similar to how Fellman discloses that the domain name that the customer wants to register (not necessarily a renewal) is entered via data fields on a computer interface as is shown in figure 3.

For claim 19, not disclosed is the step of accepting website content, accepting a one time fee for permanent web site hosting, and determining and paying all future fees associated with the domain name registration and the web site hosting service.

“Lasting respects” discloses the fact that in 1996 it was known for a web site provider to offer to host a memorial web site page on a permanent basis for a one time fee. Lasting respects discloses that Don Cazer set up a web site called "Perpetual Life Memorials" that provided customers with a web site that could be used to memorialize a deceased individual. Specifically disclosed is that for the fee of $245, one could post one photograph and one or two pages of text "*on the Internet forever, or for as long as the Internet exists.".* It was known in the art for a business on the Internet to act as a web site hosting provider that offered to maintain and operate a web site for an indefinite amount of time after payment of a one time fee, as was done by Perpetual Life Memorials. Perpetual Life Memorials is only one of numerous memorial web sites that were known in the art to provide for web site or web page hosting for the purpose of memorializing a deceased individual. Perpetual memorials just happen to be offering the service of permanent web site hosting for a fee of $245. The examiner also takes notice of the fact that it is well known in the art of domain name registrations and website operations for a business to offer both the act of registering a domain name and providing for the services that host a web site for that particular domain name. One of ordinary skill in the art at the time the invention was made would have found it obvious to not only provide the services of domain name registration and renewal, but to also provide for the hosting of a web site on a permanent basis. One of ordinary skill in the

art would be motivated to also provide for website hosting services in addition to the domain name registration services in an effort to attract and gain more business. This inherently requires accepting of web site content as claimed. If you are going to register a domain name on behalf of a domain name owner, you might as well also try to get their business in the form of providing web site hosting services to the customer as well. One of ordinary skill in the art would be aware of the fact that Perpetual memorials offered to maintain a memorial web site on the Internet forever, and along with the fact that a permanent domain name registration service is being offered in the rejection of record, one of ordinary skill in the art would have found it obvious to extend the permanent service aspect to the web site hosting as well. It would have been obvious to one of ordinary skill in the art to provide permanent web site hosting as claimed, and to determine and ensure that any bills associated with the permanent hosting of the web site can be paid and are taken care of in a similar manner as is done for the permanent domain name registration renewal service. This naturally flows from the act of charging a one time fee for permanent web site hosting, where part of the fee is used to maintain the web site now, and part of the fee is going to have to be used to maintain the web site in the future.

For claims 21,22, the claimed language regarding the use of a portion of the payment fee in a financial instrument so that interest can be earned is not disclosed in the prior art. In the rejection of record a customer is paying for a permanent registration and permanent web site hosting. When this happens there is going to be left over money after paying any currently due renewal fees to the authoritative entity for the

domain name registration and for the current web site maintenance fees. When a customer requests a permanent website hosting and pays a fee (that could be in the thousands of dollars or even the tens of thousands of dollars), not all of the money is needed to maintain the web site at this time. A person of ordinary skill in the art would easily recognize that if you received a one time fee on the order of $10,000, and you only needed maybe $100 to currently maintain and operate the web site, you would have a lot of left over money. One of ordinary skill in the art would clearly be motivated to use the extra money and put it to work in the form of some kind of investment. This could be something as simple as an interest earning savings or checking account or an interest earning certificate of deposit. Financial instruments in the form of interest earning savings and checking accounts, as well as certificate of deposit accounts are very well known in the art and the examiner takes official notice of this fact. There is no dispute that one of ordinary skill in the art is aware of interest earning accounts such as a savings account or checking account, or even a CD that earns interest. One of ordinary skill in the art who is receiving a lump sum payment in the form of a permanent registration payment fee and/or a permanent web site hosting fee, that is supposed be used to pay for future renewals of a domain name registration and future web site fees, would need to put that money aside to ensure that it is there to pay the future bills that you have already agreed to pay for by accepting the permanent registration fee and permanent web site hosting fee from the customer. One of ordinary skill in the art at the time the invention was made would have found it obvious to use a portion of the payment fee for the permanent web site hosting, and put it into a financial instrument,

such as an interest earning savings account or checking account so that interest can be earned on the extra portion of the payment fee, and so that there is money put aside to pay any and all future registration renewal fees and/or maintenance fees for hosting the web site. This is something so basic to business in general and investing in general that it is hard to see how the use of a financial instrument such as an interest earning checking account by a business owner such as Fellman involves anything more than ordinary skill in the art.

For claims 23,24, not disclosed is the use of multiple domain name system servers where the web site hosting is on a host other than the domain name server. The rejection of record includes the use of a web server in the form of a domain name server. One of ordinary skill in the art would readily appreciate that the functions and acts performed by the server can be distributed to one or more servers. This is very well known in the art of computing. It would have been obvious to one of ordinary skill in the art at the time the invention was made to use multiple servers, so that the concept of distributed computing can be put to good use and so that one single server is not responsible for the entire operation of the system and method. Having a server for domain name registrations and another server for web site hosting is well within the purview of one of ordinary skill in the art. This is such a well known concept that one of less than ordinary skill in the art would find this obvious. To separate the functions of domain name registration and web site hosting to two different servers would have been obvious to one of ordinary skill in the art.

Response to Arguments

14. Applicant's arguments filed 8/23/10 have been fully considered but they are not persuasive.

With respect to claim 2 and the fact it is an improper dependent claim, the arguments are not persuasive. Applicant is simply incorrect that this is a proper dependent claim. Applicant cannot recite a computer readable medium claim as depending from a method claim, this is simply not proper. This type of claim will not pass the "infringement test" for determining if a claim is a proper dependent claim, see MPEP 608.01(n)(III). In this case, one could infringe claim 1 without infringing claim 2, and vice versa. Claim 2 cannot contain all the elements from the claim it depends from, because it is not a method claim where steps are occurring, it is an apparatus type of claim directed to a computer readable medium. Claim 2 covers only the CRM that has the instructions, not the actual steps themselves, whereas claim 1 covers the execution of the positively recited method steps. One can have the CRM and infringe claim 2 but not be infringing claim 1. That means that claim 2 is not a proper dependent claim. Claim 2 was previously rejected correctly and is still subject to the same rejection.

With respect to the 112,2nd rejection and the 112,6th language of claim 34, it is not persuasive. The argument that the examiner could not have formulated a rejection without knowing what the language covers is not at all a persuasive argument. The instant examiner has re-visited this issue and also has concluded that the specification is not adequately disclosing the covered structure. For example, with respect to the

means for receiving a request, on page 19 of the remarks applicant is simply repeating the specification and is never actually informing the examiner of what the covered structure is. Figures 1 and 2 do not show any kind of "means for receiving" and do not make it clear what the covered structure is. Applicant has to not only disclose the function, but also the associated structure and/or acts that the means covers. This has not adequately been done. The specification may disclose that a request is received, but that is not sufficient to convey what the covered structure is. The same is found for the means for sending a response, except that for this limitation is appears to be new matter so the issue of it not being clear what is covered from the specification is relevant again. If the specification never disclosed this feature, it clearly did not convey the covered structure. Applicant claims a second means for receiving. What is that specifically and how does it differ from the first recited means for receiving a request? It is not clear what *structure* covers the means for receiving a request, and what different structure covers the means to receive the fee payment. How do they differ? This is not clear. It might be that the means for receiving are actually the same thing as they both receive data. At any rate, it is not clear what is covered by this language after consulting the specification. With respect to the means for creating an electronic record, the specification does not disclose what the covered structure is. The specification may disclose that an electronic record is created, but that is not enough to satisfy the requirement to disclose what the covered structure of the means plus function is. For the means for creating limitation, it is not clear what structure covers this language. Where did the specification disclose the structure that is used to

accomplish the act of creating an electronic record as claimed? It was disclosed that an electronic record was created, but the structure by which it is created is not disclosed and is not at all clear. The means for adding language has the same problem. What structure to the system is disclosed as accomplishing the act of adding a second portion of the fee to an investment instrument that can pay for all future fees? What structure does this? From the specification, as best the examiner can tell, the means to add the portion of the fee to an investment is a person and has nothing to do with the machine. The same is found for the limitations of the means for issuing and means for providing access. It is not clear what the associated structure is from the speciation that this 112,6th language covers.

As an example of how applicant's response is not really explaining what is covered by the means plus function language the examiner refers to the below quote from the remarks of 8/23/10. Applicant addressed the means for sending a response as follows:

> *means for sending a response from the permanent domain name server(20,* 22, 24) *to the client network device* (FIGS. 1-4, 12, 14, 16) *to request a one-time permanent registration fee,"* para. [0056]-[0060].

This is not informing anyone of what the covered structure is for the means for sending a response. The means for sending the response is not the servers 20-24, and is not the client devices. What is it? Paragraphs 56-60 are not clear as far as what applicant is relying upon to show covered structure. Also, the originally filed specification has no paragraph numbers and applicant is hereafter requested to please address the originally filed specification and not the PG publication of the application.

The PG publication is not the legal copy of the originally filed specification. The examiner has consider applicant's argument for this limitation and still is not clear as to what the covered "structure" is for the recited means plus function language.

For the means for receiving the one time fee, applicant has argued the following for covered structure:

> *means for receiving the one-time permanent registration fee payment* para. [0056]-[0060] *for the existing domain name registration on the permanent domain name system 26 server* (20, 22, 24) *from the client network device via the communications network* 18; (FIGS. 1, 2, 3) para. [0035], [0058]-[0062]

Here, for a separate limitation applicant is again referring to paragraphs 56-60, and referring to the server(s) and client device via a network. Also listed in figures 1-3 and paragraphs 35,58-62. Again, this is not explaining what the covered structure is. The means for receiving the one time fee cannot also be the server and the client device, which is what has been apparently argued for the means for sending a response. Each "means" by definition must be different and distinct structure from each other. The specific steps/structure that the computer is allegedly using and executing need to be made clear. The covered structure cannot just be the client device, network, and the server, or a generic computer programmed to provide the claimed results, that is not sufficient and is not disclosing the covered structure. The algorithm that sets for what actual steps are occurring must be disclosed.

In general, applicant's arguments are simply repeating portions of the specification that the examiner has already fully considered, with no explanation to explain why or how the specification discloses the covered structure. Repeating

portions of the specification and referring to numerous paragraphs with no supporting explanation is not persuasive.

With respect to the prior art rejection and traversal, it is deemed to be moot based on a new grounds of rejection.

15. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. “FAQ, virtual-memorials.com”, (1998) discloses the idea of a memorial on the internet where the user does not have to pay any monthly or annual fees to maintain a memorial site. That seems to be a one time fee for a permanent service of keeping something on the Internet, at least in the opinion of the examiner it can be interpreted in such a manner. “Grave sites.. on Internet” discloses the idea of online memorials and specifically mentions the web site “Perpetual memorials” that is known to have provided a memorial on the Internet forever. “Memorial Site Popping Up on the Web” discloses the fact that memorial websites, the cyberspace version of a cemetery with tombstones, are becoming very popular on the Internet. All references are deemed to be relevant to what is claimed.

16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dennis Ruhl whose telephone number is 571-272-6808. The examiner can normally be reached on Monday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner’s supervisor, Janice Mooneyham can be reached on 571-272-6805. The fax phone

number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Dennis Ruhl/
Primary Examiner, Art Unit 3689